

## REMARKS

### Priority

Applicants no longer claim priority to U.S. 09/425,228 filed 10/22/99, or 09/257,266 filed February 25, 1999, with the filing of the accompanying application data sheet and the above amendment to the specification. Priority is only claimed to provisional application 60/115,077.

### Restriction

Applicants have traversed the restriction requirement, but not on the basis that the groups identified are not patentably distinct. The restriction requirement was traversed on the basis that there is a common core to the compounds claimed such that it would not be an undue burden to examine the full scope of the claims.

### Rejection under 35 U.S.C §112

It is alleged that the specification does not reasonably provide enablement for all of the compounds encompassed by the claims.

Applicants respectfully disagree with this allegation. No evidence has been presented as to why the disclosure at page 7 to page 11 regarding the general preparation methods is inadequate. In addition, no evidence has been presented as to why the disclosure at page 11 to page 14 regarding the preparation of pharmaceuticals with the claimed compounds and the administration of such compounds is inadequate. Furthermore, no evidence has been presented as to why the more detailed preparative methods on page 18 to page 53 of the specification are inadequate.

There are over one hundred compounds exemplified in the specification, the following of which illustrate at least one of  $R_x$ ,  $R_y$ ,  $R_z$ ,  $R_a$  or  $R_b$  as a moiety other than hydrogen or lower alkyl: Examples 6, 7, 23, 26, 28, 21, 22, 40, 46, 54, 60, 61-65, 68, 70, 71, 73-84 and 112. More specifically, examples 31 and 34-40 illustrate cyclic moieties for  $R_a$  and  $R_b$  which contain up to 3 rings and 14 carbon atoms. As to the Examiner's conclusory discussion of the Wand's factors,

the Examiner has provided no reasons to doubt any of the claimed compounds are useful as disclosed or that any of the claimed compounds can not be made as disclosed. Therefore, Applicants respectfully submit the reasons given for the rejections under 35 U.S.C §112 are not viable and the rejection should be withdrawn.

In making a non-enablement rejection, it is incumbent upon the Patent and Trademark Office to provide reasons as to why enablement is insufficient. No reasons have been provided why the disclosure mentioned above is inadequate. In addition, as long as a skilled worker can make the compounds, he or she can routinely test them to determine their relative activity. This degree of effort is fully routine, beginning nothing more than that expended by skilled workers on a day to day basis in the field. The test for enablement is not whether experimentation is needed, but whether the experimentation is undue. See *In re Angstadt*, 190 USPQ 214, 219 (CCPA 1976) and *In re Wands*, 8 USPQ 2d. 1400, (Fed. Cir. 1988).

Accordingly Applicants maintain the full scope of the subject matter within original claims 1-67 is enabled as well as the subject matter.

#### 35 U.S.C §112

It is alleged the claims contain subject matter that is not adequately described in the specification. However, no language within these claims has been shown to be ambiguous or indefinite. It is alleged that there is a lack of written description of the types of groups defined by C<sub>1</sub> - C<sub>40</sub> or C<sub>1</sub> - C<sub>24</sub>, optionally containing heteroatoms such as S, O and N. However it has not been demonstrated where this language is ambiguous or indefinite.

Examples of such groups are not necessary for one skilled in the art to understand what is encompassed by this language, nevertheless, examples of such groups are illustrated in the examples, as discussed above, and preferred subgeneric groups of these moieties are defined in claim 2 and other dependent claims. When the specification is considered as a whole, this broad language is clearly definite and unambiguous.

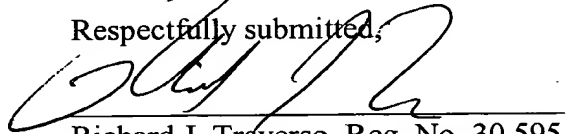
When allowable subject matter has been identified, Claims 60 and 66 will be cancelled and replaced with a listing of compounds which conform to the elected subject matter.

Double Patenting

This provisional rejection will be addressed when claimed subject matter, which is otherwise allowable, has been identified.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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